



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,726	09/02/1999	DR. HOWARD AN	OSTEONICS3.0	4364

530 7590 11/14/2002

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/388,726

Applicant(s)  
An et al.

Examiner  
Brian Pellegrino

Art Unit  
3738



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 14, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-41 is/are pending in the application.
- 4a) Of the above, claim(s) 16, 17, and 34-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-13, 15, 18, 26-33, and 41 is/are allowed.
- 6) ☒ Claim(s) 14 and 19-25 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3738

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 2 and 3 are objected to because of the following informalities: the claims depend from a canceled claim. Appropriate correction is required.

### ***Claim Rejections - 35 U.S.C. § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 19 and 20 recite the locking clip includes "third and fourth surface portions" in paragraph c) of the claims. It is not clear how the locking clip is intended to have four surfaces because it fails to recite what forms the first and second surface portions.

### ***Claim Rejections - 35 U.S.C. § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schar et al. (WO 98/46173) in view of Rabbe et al. (5702453). Schar shows (Fig. 3) shows a vertebral implant

Art Unit: 3738

having a first member 2 and a second member 1 that is telescopingly received in said first member. However, Schar does not disclose perforations in the first member. It can also be seen the first and second members have outwardly extending flanges 39,38 respectively thereon with teeth 40. Fig. 4 shows a locking clip 13 of which has threads on its inner surface that engage the second member member 1 and also engages the first member when moving since the clip is a spring and the force on it pushes against the wall of the first member. However, Schar does not disclose the flanges being formed at an acute angle. Rabbe teaches (Fig. 3) a flange 35 of an outer end of a vertebral body implant that is at an acute angle since the body of the tubular member is sloped. It would have been obvious to one of ordinary skill in the art to use an acute angled flange as taught by Rabbe with the prosthesis of Schar in order to match the contours of the spine.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schar et al. (WO 98/46173) in view of Wu (4553273). Schar et al. is explained supra. However, Schar does not disclose an outer surface different than the inner surface of the tubular members. Wu teaches that moveable components that operate with respect to one another along a longitudinal axis have surfaces that are preferably polygonal for gripping. It would have been obvious to one of ordinary skill in the art to use the teaching of Wu to provide polygonal shaping on the outer surface of the prosthesis of Schar in order to enable the surgeon to have a secure grip that enables proper placement in the patient.

Art Unit: 3738

***Response to Arguments***

4. Applicant's arguments with respect to claim 14 have been considered but are moot in view of the new ground(s) of rejection. Also the reply was not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant failed to address the remarks about the indefiniteness of the surfaces in claim 20 making it unclear. Claim 25 is independent and does not depend from 41. These rejections are maintained.

***Allowable Subject Matter***

5. Claims 26-33, 41, 4, 5-13<sup>18</sup> are allowed.

6. Claims 19, 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino TC 3700, AU 3738

*Brian Pellegrino*

Bruce Snow Primary Examiner

*Bruce Snow*